

## **REMARKS**

The Examiner is thanked for acknowledging that Applicant's remarks, set forth in the pre-appeal request for review filed on July 30, 2008, were persuasive, and for withdrawing the previous rejections. The Examiner is also thanked for the allowance of claims 16-18 and 20, and for the indication that claims 5, 7, 12, and 13 embody allowable subject matter.

The present Office Action, however, has continued to reject the remaining claims on new grounds. In this regard, the present Office Action cites eight new references, which are listed on the PTO-892 form, which accompanied the Office Action. MPEP 904 et seq. requires:

"The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed."

With so many new references cited in the latest Office Action, it appear that the previous examination may not have complied with the requirements of MPEP 904 (as well as MPEP 707.07(g), which admonishes against piecemeal examination). Applicant would like the Examiner's clarification on this point (i.e., an explanation as to why these newly cited references were not previously identified and made of record).

### **Discussion of Rejections**

Claims 1, 3, 4, 6, 8, 9, 11, 14, and 15 stand rejected under U.S.C. 102(e) as allegedly being anticipated by Kobayashi et al. (US Patent Application Publication No.

2003/0204280). Applicant respectfully requests reconsideration and withdrawal of these rejections.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ 2d 1655 (Fed. Cir. 1990).

Among these rejected claims, claims 1 and 9 are independent claims. Claim 9 is rejected on the same basis as claim 1. Therefore, remarks are provided regarding to patentability of the independent claim 1.

The claimed embodiments define a tool stocking and sorting system and method, wherein the tool is a reticle. The limitation “the tool is a reticle” is a significant and defining feature of the claimed embodiments, and has been clearly specified in claim 1. The Office Action, however, seems to ignore this limitation. Remarks pertaining to the patentability of claim 1 are provided below.

Claim 1 expressly recites:

1. A tool stocking and sorting system, comprising:  
first tool storage storing a first tool currently in use;  
second tool storage storing a second tool not currently in use;  
third tool storage serving as an outlet for a third tool not in use; and  
**a host system adapted to re-locate the first, second, and third tools among the first, second, and third storage as a function of demand data pertaining to a product corresponding to the respective tool, wherein the tool is a reticle.**

(*Emphasis added*). Claim 1 patently defines over the cited art for at least the reasons that the cited art fails to disclose the features emphasized above. In this regard, Kobayashi does not disclose a **tool (reticle)** stocking and sorting system.

The Office Action (page 2) states that 'TEQ1' of Kobayashi discloses "first tool storage storing a first tool currently in use" of claim 1; and 'TEQ2' of Kobayashi discloses "second tool storage storing a second tool not currently in use" of claim 1. These statements, however, are not properly supported by the teachings of Kobayashi.

According to Kobayashi, 'TEQ1' and 'TEQ2' are transfer apparatuses for transferring lots to respective manufacturing apparatuses (see paragraph [0057]). In contrast, according to claim 1, first tool storage stores a first tool currently in use, wherein the tool is a reticle; and second tool storage stores a second tool not currently in use, wherein the tool is a reticle. Accordingly, claim 1 defines a "first reticle storage storing a first reticle currently in use," and a "second reticle storage storing a second reticle not currently in use."

To one of ordinary skill in the art, the feature of 'transfer apparatuses for transferring lots to respective manufacturing apparatuses' of Kobayashi does not teach two distinct reticle storages for storing 'a reticle currently in use' and 'a reticle not currently in use', respectively. For at least this reason, the rejection of claim 1 should be withdrawn.

The Office Action (page 2) also alleged that 'LS' of Kobayashi discloses "third tool storage serving as an outlet for a third tool not in use," as recited in claim 1. Applicant disagrees.

According to Kobayashi, 'LS' represents 'lot storage' for storing lots (see e.g., paragraph [0088], Figs. 7-12). In contrast, according to claim 1, third tool storage serving as an outlet for a third tool not in use, wherein the tool is a reticle. Accordingly, claim 1 teaches a "third reticle storage serving as an outlet for a third reticle not in use".

To one of ordinary skill in the art, the feature of "lot storage for storing lots" of Kobayashi does not teach a reticle storage serving as an outlet for a third tool not in use.

In addition, the Office Action (page 2) alleged that 'FHST' of Kobayashi discloses "host system adapted to re-locate the first, second, and third tools among the first, second, and third storage as a function of demand data pertaining to a product corresponding to the respective tool" of claim 1.

According to Kobayashi, 'Operations of these manufacturing apparatuses and transfer apparatuses are managed and controlled by a factory host FHST' (see e.g., paragraph [0057]). More specifically, the 'manufacturing apparatuses' of Kobayashi performs respective wafer processing step, and the 'transfer apparatuses' of Kobayashi transfers lots (paragraph [0057]).

In contrast, according to claim 1, host system adapted to re-locate the first, second, and third tools among the first, second, and third storage as a function of demand data pertaining to a product corresponding to the respective tool, wherein the tool is a reticle. Accordingly, claim 1 defines a "host system adapted to re-locate the first, second, and third reticles among the first, second, and third reticle storage as a function of demand data pertaining to a product corresponding to the respective reticle."

To one of ordinary skill in the art, the feature of 'managing and controlling manufacturing apparatuses and transfer apparatuses' of Kobayashi does not teach a host system adapted to re-locate the first, second, and third reticles among the first, second, and third reticle storage as a function of demand data pertaining to a product corresponding to the respective reticle.

Further still, based on the disclosure of Kobayashi, none of the terms (lot, semiconductor wafers, product) can be properly interpreted as a reticle.

To one of ordinary skill in the art, the lots taught by Kobayashi and the reticles defined in the claimed embodiments are different in nature. The lot (referred to as semiconductor wafer or product) taught by Kobayashi is the subject matter that is actually being processed; while the tool (reticle) defined in the claimed embodiments is used during process procedures but not being processed itself, and can be reused repeatedly. The fact that a reticle is used as a tool in semiconductor manufacturing and that a reticle is used repeatedly are common sense for one of ordinary skill in the art. To one of ordinary skill in the art, the described characteristics of tool (reticle) are implied in the claim language "reticle." Because the tools can be reused, difference in usage frequency exists among different tools. The claimed embodiments define three distinct storages (i.e., the "first tool storage", "second tool storage", and "third tool storage") for storing tools from currently in use to left unused. The difference in nature, the method of handling tools taught by the claimed embodiments cannot be properly anticipated by the method of processing lots taught by Kobayashi.

For at least the foregoing reasons, the teachings of Kobayashi do not suggest all features of the claim 1 to one of ordinary skill in the art. Accordingly, the rejection of

claim 1 should be withdrawn. On the same bases as claim 1, the rejection of claim 9 should be withdrawn. Insofar as all remaining rejected claims depend from claim 1 or claim 9, all remaining rejections should be withdrawn for the same reasons. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Conclusion**

In view of the foregoing remarks, Applicant respectfully requests reconsideration of the application and the timely allowance of claims. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this submission. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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